

Application No. 10/801,321

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Response to Office Action and Request for Reconsideration

REMARKS

Claims 1-11, 13, 15-23 and 25 are pending in this application. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this Response, claims 1, 3, 6, 8, 9, have been amended, claims 2, 15-23, and 25-26 are canceled without prejudice to future prosecution, new claims 27-106 have been added. All claims are presented with markings indicating their current status. These amendments and new claims add no new matter. Support for the amendments and new claims may be found in numerous parts of the specification.

Information Disclosure Statement

In paragraph 2 of the Office Action the Examiner asserts that the Information Disclosure Statement provided on April 14, 2005 fails to comply with 37 CFR 1.98(a)(2) for failing with respect to the requirement to provide a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information, or that portion that caused it to be listed. By this response additional copies of the references contained on the April 14, 2005 Information Disclosure Statement are provided.

Rejection Under 35 U.S.C. § 102(e)

In Paragraph 5 of the Office Action, pending claims 1-5, 7-9, 11, and 13 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,892,941 ("Rosenblum"). As discussed below, Applicant respectfully traverses this rejection.

The Law of Anticipation and Enabling Prior Art References

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P.

§ 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*

However, Applicant submits that independent claim 1, as amended, has elements that cannot be found, either expressly or inherently, in Rosenblum. Specifically, Rosenblum fails to teach “creating a finished prescription by filling the particular customer’s prescription with the chosen prescription drug; and placing the finished prescription in a random location within a dispenser.” Rosenblum teaches a dispenser that contains “products” and “supplies”. (column 13, lines 4-11). The method taught by Rosenblum uses pre-filled medication bottles contained in magazines. (column 15, lines 22-23). Rosenblum does not teach, imply, or suggest any method of storing customer specific, pharmacy-filled prescriptions in random storage locations and then delivering “finished prescriptions” that have been filled for a particular customer as recited in amended claim 1. Rosenblum also fails to teach placing finished prescriptions in a random locations. Rosenblum does not teach a device designed to handle pharmacy filled prescriptions, as such Rosenblum’s device cannot handle the infinite variety of prescriptions that the Applicants methods can provide. Instead, Rosenblum’s device, and methods, are limited to distinct products.

Additionally, Rosenblum seeks to store pre-filled medication bottles, and then label those pre-filled medication bottles after the customer interfaces with the machine. Thus, in Rosenblum’s device, the stored medication does not become a prescription in the legal sense of the word until after the customer has interfaced with the device, the pre-filled medication bottle is labeled, and then becomes associated with a specific customer. Thus Rosenblum has no ability to store any, let alone a plurality of customer-specific, pharmacy filly prescriptions as illustrated in the methods provided by the Applicant.

This distinction is not trivial as the pharmaceutical industry is one of the most highly regulated industries in the country. The claimed method is directed to delivery of finished prescriptions, i.e., prescriptions that have been filed by pharmacists according to the mandates, laws, and regulations governing such activities. Additionally, the

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finished prescription includes all necessary identifying information that is printed on the finished prescription, which may include patient name, prescription, prescription number, refills remaining, expiration date, pharmacy name, address and phone number, date filed, dosage information, instructions, side effects, prescribing doctors name and a unique barcode printed on the label by the filling pharmacy. In stark contrast, Rosenblum simply stores unassociated, non-specific medication bottles, not the type of highly regulated finished prescription described in the claimed methods.

Accordingly, Applicants respectfully submit that Rosenblum does not anticipate or render obvious independent claim 1, as amended, and the rejection to that claim has been traversed. As dependent claims 2-5, 7-9, 11 and 13 depend from and further define the invention as recited in independent claim 1, the dependent claims are patentably distinct from the art being considered. Therefore the Applicants respectfully request the Examiner reconsider and withdraw the rejection to these claims.

In paragraph 5 of the Office Action the Examiner rejects claims 15-17, 19-21, 23 and 25 under 35 U.S.C. §102(e) as being anticipated by Rosenblum. By this response, claims 15-23 and 25-26 have been canceled rendering this rejection moot.

Rejection Under 35 U.S.C. § 103

In paragraph 7 of the Office Action, claims 6 and 22 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Rosenblum in view of U.S. Patent 6,877,655 ("Robertson"). Applicant respectfully traverses this rejection.

The Law of Obviousness

In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach

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or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." M.P.E.P. § 2142.

Any combination, proper or improper, of the Rosenblum and the Robertson references would not teach or suggest all of the claim limitations in dependent claims 6. As claim 22 has been canceled, this rejection to that claim is moot.

The Examiner states that "Rosenblum teaches all elements per claimed methods including the usage of smartcard to authorize the dispensing transaction." Further, the Examiner relies on Robertson to provide a "barcode reader". As discussed above, Rosenblum does not teach a "finished prescription" filled for a particular customer as recited in amended claim 1 or placing that prescription in a random location within a dispenser.

Because claims 6 depends from claims 1 it is respectfully submitted that the rejection of claim 6 has been traversed by virtue of its dependency from claims 1. M.P.E.P. § 2143.03.

In paragraph 8 of the Office Action the Examiner rejects dependent claims 10 and 22 under 35 U.S.C. § 103(a) over Rosenblum in view of U.S. Patent 6,874,684 ("Denenberg"). Applicant respectfully traverses this rejection. As claim 22 has been canceled, this rejection to that claim is moot.

In this rejection the Examiner asserts that Rosenblum teaches all elements per claimed methods, but is silent as to the specifics of recording a customer's signature to purchase the finished prescription. As discussed above, Rosenblum fails to teach important elements of independent claims 1, as amended. Therefore in combination with and reliance on Denenberg for "the specifics of recording a customer's signature to purchase the finished prescription" still fails to teach the elements discussed above.

Because claim 10 depends from claim 1, it is respectfully submitted that the rejection of claim 10 has been traversed by virtue of its dependency from claims 1. M.P.E.P. § 2143.03.

In paragraph 9 of the Office Action the Examiner rejects claims 1-4, 7, 8, 13, 15, 16, 19, 20, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,814,255 ("Liff"). Applicant respectfully traverses this rejection. By this response claims 15-23 and 25-26 have been canceled rendering this rejection to claims 15-16, 19, 20, and 25 moot.

In rejecting these claims the Examiner states

"The method comprises prepackaging prescription container per customer's prescription..."

Please refer to the above discussion related to the nature of the present invention and the Rosenblum reference, the same analysis applies equally to the Liff reference. The Applicant submits that the Examiner's argument is moot in light of the amendment to independent claim 1. Like Rosenblum, Liff's methods relate to prepared medications not finished prescriptions. Liff teaches "[p]repackaged pharmaceuticals are stocked at nearby municipal service centers and distributed to the health care locations as needed." (Column 5, lines 2-4) "Prepackaged multiple-dose pharmaceuticals are available to practitioners at the health-care facility for immediate filling of patient prescriptions." (Column 5, lines 7-10). Applicant submits that inherent in prepackaging is the limitation that there is no patient with a specific prescription. Using prepackaged pharmaceutical would not supply the numerous elements of independent claim 1, as amended, including "creating a finished prescription by filling the particular customer's prescription". Additionally, Liff fails to teach a device or methods of placing the finished prescription in a random location within a dispenser, or associating the finished prescription with a random location in the dispenser. The device and methods taught by the Liff reference are not capable of random placement of finished prescriptions. To apply the teachings of Liff to the present invention would fundamentally change the principles of operation of the Liff reference. Since dependent claims 2-4, 7, 8 and 13 depend from and further limit the scope of independent claim 1, this rejection is traversed by their dependency. The Applicant respectfully requests the Examiner reconsider and withdraw this rejection to these claims.

In paragraph 10 of the Office Action the Examiner rejects dependent claims 5, 6, 11, 17, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Liff in view of Robertson. Applicant respectfully traverses this rejection. As claims 17, 22, and 23 have been canceled this rejection to those claims is moot.

In rejection of claims 5, and 6, the Examiner relies on Robertson provide a “commonly well-known electronic card that includes magnetic strip and barcode.” The rejection relies on Liff for the remaining elements of the claims. As discussed above, Liff fails to provide important elements of independent claim 1 in that Liff teaches prepackaged pharmaceuticals. Liff does not teach or imply finished prescriptions created by filing a particular customer's prescription and placing in a random location within a dispenser as recited in amended claim 1. The applicant submits that any combination, proper or improper, of Liff with Robertson would fail to teach important elements of the independent claims. Since dependent claims 5, and 6 depend from and further limit the scope of the independent claim 1, the rejection to these dependent claims has been traversed by virtue of their dependency from patentably distinct independent claim 1. The applicant respectfully requests the Examiner reconsider and withdraw this rejection.

In paragraph 11 of the Office Action the Examiner rejects dependent claims 9 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Liff in view of Rosenblum. Applicant respectfully traverses this rejection. Since claim 21 has been canceled, the rejection to this claim is moot.

In this rejection the Examiner states that Liff discloses all elements per claimed invention, but relies on Rosenblum for the claim 9 element of “using a prescription number. As discussed above, the Liff reference does not teach, imply, or suggest important elements, not provided by Robertson. Specifically, “creating a finished prescription by filling the particular customer's prescription” or placing that prescription in a random location within a dispenser as recited in claim 1.

The applicant submits that any combination, proper or improper, of Liff with Rosenblum would fail to teach important elements of the independent claims. Since

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dependent claim 9 depends from and further limit the scope if the independent claim 1, the rejection to this dependent claim has been traversed by virtue of its dependency from patentably distinct independent claim 1. The applicant respectfully requests the Examiner reconsider and withdraw this rejection.

Additionally, in paragraph 11 the Examiner rejects claim 11, relying on Liff to teach essential elements that are not taught, suggested, or implied by the Liff reference. See above discussion. The applicant submits that any combination, proper or improper, of Liff with Rosenblum would fail to teach important elements of the independent claim. Since dependent claim 11 depends from and further limit the scope if the independent claim 1, the rejection to this dependent claim has been traversed by virtue of its dependency from patentably distinct independent claim 1. The Applicants respectfully request the Examiner reconsider and withdraw this rejection.

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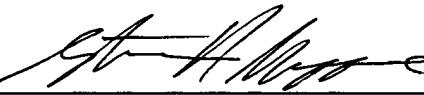
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Conclusion

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of all claims at an early date is solicited. The fee for additional claims is included with this response. The Commissioner is authorized to charge any fee required to our Deposit Account No. 50-1213, in the name of Heller Ehrman LLP. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,
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